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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,429	10/28/2003	David Mathieu	2185.004USU	9460

56080 7590 03/29/2007
WHYTE HIRSCHBOECK DUDEK S.C.
ONE EAST MAIN STREET
SUITE 300
MADISON, WI 53703-3300

EXAMINER

HAMILTON, ISAAC N

ART UNIT	PAPER NUMBER
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3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/695,429

Applicant(s)

MATHIEU ET AL.

Examiner

Isaac N. Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-22, 24, 25, 27 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 23, 26, 28-32, 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-22, 24, 25, 27, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>06/21/04, 06/29/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant has admitted that claims 23 and 26 do not read upon elected Species I, and subsequently has withdrawn these claims.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 27. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The amendment filed 09/05/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the last 3 sentences of the paragraph starting at page 8, line 5, and the features added to figure 4 between the lead-line for element number 27

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and the lead-line for element number 41; the last sentence of the paragraph bridging pages 7 and 8. This new matter was introduced in the amendment to the specification in the last response filed 09/06/06. Applicant has not provided any statement to support the position that the subject matter is described in the specification as filed. One of ordinary skill in the art would not have known that element 41 in figure 4 of the drawings filed 10/28/03 was a locking mechanism. Also, one of ordinary skill in the art would not have known that element 25 was a blade mounting surface, or what function the blade mounting surface serves in the apparatus as originally filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

4. The objection to the claims is hereby withdrawn.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 19-22, 24, 25, 27, 38 and 39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 19, 38 and 39 include the limitation "a mounting structure" however, it is not clear how this blade mounting surface interacts with the blade, and it is not clear what function the "mounting structure" serves in the apparatus. The "mounting structure" is recited in

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the last sentence of the paragraph bridging pages 7 and 8. Moreover, the addition of this information to the disclosure is deemed to be new matter. This new matter was introduced in the amendment to the specification in the last response filed 09/06/06. Applicant has not provided any statement to support the position that the subject matter is described in the specification as filed. One of ordinary skill in the art would not have known that element 25 was a blade mounting surface, or what function the blade mounting surface serves in the apparatus as originally filed.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 19-22, 24, 25, 27, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Brening (957,409). Brening discloses blade carriage a8; mounting structure a2; cutting blade b; guard a; cutting blade b and guard 1 are together removable by unscrewing the screw in the groove and sliding roller a4 out of the other element labeled a1 in Brening; clip is the screw that secures guard a to blade b; each end of the carriage a8 is a handle because the extensions adjacent to elements a3 have enough surface area to permit a user to grasp the extensions and use them as handles, and alternatively, a10 is interpreted to satisfy the handle limitation; arcuate pad a10 as shown in diagram 1; actuator a10, a6, a4, a1; operative position and inoperative position in column 2, lines 68-83; linear path is collinear with the longitudinal axis of grooves a1 and is oblique to the cutting surface shown in figure 2; trigger a10; blade

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mounting element a5. The handle a10 is “on the blade carriage” because a10 is supported by blade carriage a8 via a, a1, a2, a4 and a3. Note that cutting blade b and guard a are connected via a screw located at the center of the blade b, and that the blade and the guard form an integral blade-guard assembly that can be removed from the blade carriage by unscrewing the fastener engaged in a3 as shown in figures 2 and 3.

9. Claims 19-22, 24, 25, 27, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Brening (957,409). Brening discloses blade carriage a2; mounting structure a8; cutting blade b; guard a; clip is the screw that secures guard a to blade b; each end of the carriage a2 is a handle because the extensions adjacent to elements a3 have enough surface area to permit a user to grasp the extensions and use them as handles, and alternatively, a10 is interpreted to satisfy the handle limitation; arcuate pad a10 as shown in diagram 1; actuator a10, a6, a4, a1; operative position and inoperative position in column 2, lines 68-83; linear path is collinear with the longitudinal axis of grooves a1 and is oblique to the cutting surface shown in figure 2; trigger a10; blade mounting element a5. The cutting blade b is “received on said mounting structure” via element a2. The handle a10 is “on the blade carriage” because a10 is supported by blade carriage a2 via a, a1, a4 and a3. Note that cutting blade b and guard a are connected via a screw located at the center of the blade b, and that the blade and the guard form an integral blade-guard assembly that can be removed from the blade carriage by unscrewing the fastener engaged in a3 as shown in figures 2 and 3.

10. Claims 19-22, 24, 25, 27, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Ridgely (909,227). Ridgely discloses blade carriage 1; mounting structure 7, 10, 11; cutting blade 26; guard 13; clip 27, 18, 29, 30, 31; elements 9 and 12 are a handle because

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the extensions adjacent to elements 9 and 12 have enough surface area to permit a user to grasp the extensions and use them as handles, and alternatively, 15 is interpreted to satisfy the handle limitation; arcuate pad 15 as shown in diagram 1; actuator 15, 23, 13; inoperative position in figures 1 and 2; linear path is collinear with the longitudinal axis of slot 23 and is oblique to a cutting surface that is collinear with the bottom edge of blade carriage 1; trigger 15; blade mounting element 25. The handle 15 is "on the blade carriage" because 15 is supported by blade carriage 1 via elements 2, 6, 3, 4, 5. Note that cutting blade 26 and guard 13 are connected via elements 27, 18, 29, 31 and that the blade and the guard form an integral blade-guard assembly that can be removed from the blade carriage by sliding element 24 out of elements 4 and sliding element 6 out of element 23.

11. Claims 19-22, 24, 25, 27, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Ridgely (909,227). Ridgely discloses blade carriage 7, 10, 11; mounting structure 1; cutting blade 26; guard 13; clip 27, 18, 29, 30, 31; elements 9 and 12 are a handle because the extensions adjacent to elements 9 and 12 have enough surface area to permit a user to grasp the extensions and use them as handles, and alternatively, 15 is interpreted to satisfy the handle limitation; arcuate pad 15 as shown in diagram 1; actuator 15, 23, 13; inoperative position in figures 1 and 2; linear path is collinear with the longitudinal axis of slot 23 and is oblique to a cutting surface that is collinear with the bottom edge of blade carriage 7, 10, 11; trigger 15; blade mounting element 25. The handle 15 is "on the blade carriage" because 15 is supported by blade carriage 7, 10, 11 via elements 1, 2, 6, 3, 4, 5. Note that cutting blade 26 and guard 13 are connected via elements 27, 18, 29, 31 and that the blade and the guard form an integral blade-guard assembly that can be removed from the blade carriage by sliding element 24 out of

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elements 4 and sliding element 6 out of element 23. The cutting blade 26 is “received on said mounting structure” via elements 27, 18, 13, 1.

12. Claims 19-22, 24, 25, 27, 38 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Ridgely (909,227). Ridgely discloses blade carriage 1; mounting structure 27, 18; cutting blade 26; guard 13; clip 29; elements 9 and 12 are a handle because the extensions adjacent to elements 9 and 12 have enough surface area to permit a user to grasp the extensions and use them as handles, and alternatively, 15 is interpreted to satisfy the handle limitation; arcuate pad 15 as shown in diagram 1; actuator 15, 23, 13; inoperative position in figures 1 and 2; linear path is collinear with the longitudinal axis of slot 23 and is oblique to a cutting surface that is collinear with the bottom edge of blade carriage 1; trigger 15; blade mounting element 25. The handle 15 is “on the blade carriage” because 15 is supported by blade carriage 1 via elements 2, 6, 3, 4, 5. Note that cutting blade 26 and guard 13 are connected via elements 27, 18, 29, 31 and that the blade and the guard form an integral blade-guard assembly that can be removed from the blade carriage by sliding element 24 out of elements 4 and sliding element 6 out of element 23.

Response to Arguments

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

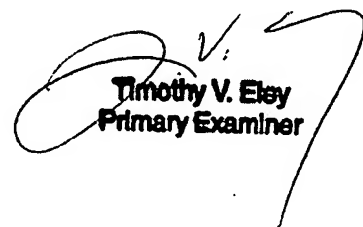
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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March 25, 2007


Timothy V. Eley
Primary Examiner